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T.W.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Venegas, Jr.

Serial No.: 09/779,782

Group No.: 3635

Filed: Feb. 8, 2001

Examiner: S. Varner

For: BARRIER COVER

APPELLANT'S BRIEF UNDER 37 CFR §1.192

Mail Stop Appeal Brief
Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real party and interest in this case is Frank Venegas, Jr., Applicant and Appellant.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 7 claims. Claim 1 was canceled, and claims 8-9 were added in November 2002. Claims 2-9 are under appeal.

**IV. Status of Amendments Filed Subsequent
Final Rejection**

No after-final amendments have been filed.

V. Concise Summary of the Invention

The present invention discloses a low maintenance protective cover for use with a substantially

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semi-circular or arching guard post. Additionally, the cover preferably supports an advertising display for displaying an advertisement, logo, or message (Specification, page 3, lines 2-4). Typically, the arching barrier posts are formed of elongated tubular steel body having a hollow or concrete core that extends substantially semi-circularly between its two opposite ends resulting in these ends and portions of the tubular body, that will subsequently be referred to as legs, being adjacent and separated by a fixed distance with an arching portion bridging the distance between the two legs (Specification, page 3, lines 5-9). In construction, the post has its opposite ends and a substantial portion of the tubular body embedded in a fixed surface while the vertex of the arch extends outwardly from the fixed surface (Specification, page 3, lines 9-11). The body of the post is typically 6 to 8 inches in diameter, although it is recognized that other configurations may have a diameter greater or less for an intended use (Specification, page 3, lines 12-14). The linear distance that separates substantial portions of the legs of the substantially semi-circular tubular steel body and the two opposite ends is on the order of 50 inches, although, again, other embodiments may command a distance greater or less for an intended use (Specification, page 3, lines 14-17). In a preferred embodiment, the cover is dimensioned to receive the barrier post in slip-fit engagement and adapted to support an advertising display such as a message of stenciled letters, an electrical/electronic circuit comprising one or more lighting elements configured to display a message or image, one or more magnetically mounted objects of a ferro-magnetic material supported on metallic surface, Velcro materials, peg boards, a chalkboard surface, or combinations thereof (Specification, page 3, line 18 to page 4, line 2). The lighting elements in the cover assembly may be supported by either an internal or external power supply, and the cover assembly may further include an electronic circuit composed of components necessary for power control and management (Specification, page 4, lines 3-5). Preferably, for security purposes, the cover may include a fastening means for securing it to the fixed surface, such as L brackets and screws or other suitable fastening means (Specification, page 4, lines 6-7).

VI. Concise Statement of Issues Presented For Review

1. Are claims 2-7 unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 3,874,103 to Muta in view of U.S. Patent No. 2,678,707 to Finkelstein?

2. Are claims 8-9 anticipated by U.S. Patent No. 3,874,103 to Muta under 35 U.S.C. §102(b)?

VII. Grouping of Claims for Each Ground of Rejection Which Appellant Contends

Appellant believes the following groups of claims represent patentably distinct inventions which should be given independent consideration on appeal:

Group I: Claims 2 and 4;

Group II: Claim 3;

Group III: Claim 5;

Group IV: Claim 6;

Group V: Claim 7; and

Group VI: Claims 8 and 9.

VIII. Argument

A. Group I - Claims 2 and 4.

Claim 2 includes the limitation of a protective cover according to claim 8, wherein at least one of the front and back panels includes an advertising display. Claim 2 stands rejected under 35 U.S.C. §103(a) over Muta in view of Finkelstein. The Examiner concedes that Muta does not show an advertising display, fastening means, or stenciled letters. With regard to claims 2-4, the Examiner contends that since Finkelstein shows an advertising display, fastening means and stenciled letters, "it would have been obvious to one of skill in the art ... to have an advertising display to market goods, fastening means to hold the cover to the rail, and stenciled letters to create an advertisement." The Examiner is clearly using the wrong standard under §103 of the Statute. In rejecting claims under 35 U.S.C. §103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In Re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 5569, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art

references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657,664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In Re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

With regard to the claims of this group, the combination of Muta and Finkelstein *teach away* from applying any sort of letters or advertising display onto the “bubble” of Muta, since it would obscure visual indicia *already provided* inside the bubble. The sole purpose of the bubble member of the Muta patent is to be transparent in all respects so that the encased visual material 20 is protected. “The bubble member 24 can be formed of a variety of transparent materials, including glass as well as high impact, transparent plastics.” (Column 2, lines 50-53.) Appellant is not saying one could not put letters on a transparent substrate; rather, that in this case, it would defeat the purpose of the Muta invention, thereby precluding *prima facie* obviousness.

B. Group II: Claim 3.

Claim 3 includes the limitation of a fastener “for securing the cover to the guard rail.” The Examiner does not really address this rejection with any substantive argument, he simply states that it would be obvious to include “fastening means” to hold the cover to the rail ...”. While Appellant does not clearly know to which “rail” the Examiner is referring, but in any case, for the reasons set forth above (citations omitted), the combination of Muta and Finkelstein makes no sense. With regard to fastening means of this group of claim, the luggage handle of Finkelstein simply gets attached through the stems 10 which are “peened” over, whereas the bubble 24 of Muta simply gets slipped on. Indeed, “for this purpose, the bubble member 24 is provided with a slot 21 in the rear face 26; the slot 28 is dimensioned to receive the spacing member ...”. (Muta, column 2, lines 59-63.) Again, there being no teaching or suggestion *from the prior art*, as to the proposed combination of elements represented by

claim 3, *prima facie* obviousness is precluded in this case as well.

C. Group III: Claim 5.

Claim 5 includes the limitation of an advertising display incorporating an electrical/electronic circuit with lighting elements to display a message or image. Incredibly, the Examiner concedes that Finkelstein does not show a lighting element, but that these are “well known in the art.” Appellant wonders how the Examiner can take “official notice” of the existence of something and, at the same time, support an argument that the combination of element is *suggested by the prior art*. Clearly it is not, and the rejection of claim 5 should be withdrawn.

D. Group IV: Claim 6.

Claim 6 includes the limitation of an advertising display including one or more magnetically objects on a metallic surface. Again, the Examiner concedes that neither Muta nor Finkelstein teach the use of a magnetically mounted object on a metal surface, but it would have been “obvious to one of skill in the art ...” to use a magnetically mounted element in the structure of Finkelstein as a “good ways” [sic] to present the advertising message. Among the problems with this argument are that Finkelstein is directed to a luggage handle, such that a magnetically mounted object would simply come off, be lost, and defeat the entire purpose of the ‘707 patent. Obviously, obviousness is precluded.

E. Group V: Claim 7.

Claim 7 includes the limitation of an advertising display in the form of a hook-and-loop material or chalkboard surface. Again, the Examiner concedes that neither Finkelstein nor Muta show such elements, but that their inclusion would again represent “good ways” to present the advertising message. There is simply no teaching or suggestion from the prior art in support of such a conclusion, and for this reason claim 7 should be deemed allowable as well.

F. Group VI: Claims 8 and 9.

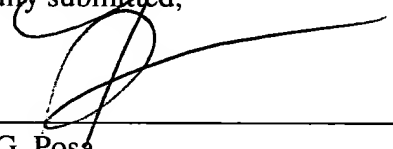
Appellant chooses not to argue the rejection of claim 8 and 9 at this time.

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

Respectfully submitted,

By: _____


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Date: May 27, 2003

APPENDIX A
CLAIMS ON APPEAL

- 102 *muta*
2. The protective cover of claim 8 wherein at least one of the front and back panels includes an advertising display.
- 102 *muta*
3. The protective cover of claim 8 further including a fastener for securing the cover to the guard rail.
- 103 *muta*
4. The barrier cover of claim 2 wherein the advertising display is a message of stenciled letters.
5. The barrier cover of claim 2 wherein the advertising display is an electrical/electronic circuit comprising one or more lighting elements configured to display a message or image.
6. The barrier cover of claim 2 wherein the advertising display is one or more magnetically mounted objects of a ferro-magnetic material disposed on metallic surface.
7. The barrier cover of claim 2 wherein the advertising display is hook-and-loop materials or a chalkboard surface.
8. A cover for a tubular metal guard rail of the type having two below-ground ends and a substantially semi-circular above-ground midsection connecting the two ends, the cover comprising:
spaced-apart front and back panels, each having a corresponding bottom edge, opposing side edges and a top edge; and
a side panel connecting the sides and tops of the front and back panels, leaving a slot open at the bottom to receive the metal guard rail in slip-fit engagement such that the bottom edges are adjacent the ground surface.

9. The cover of claim 8, wherein the side edges smoothly transition in the top edge to create arc-shaped front and back panels that correspond to the semi-circular mid-section of the guard rail.



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TRANSMITTAL OF APPEAL BRIEF (Small Entity)

Docket No.
IDS-14502/14

Re Application Of: Venegas, Jr.

Serial No.
09/779,782

Filing Date
Feb. 8, 2001

Examiner
S. Varner

Group Art Unit
3635

Invention: BARRIER COVER

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:
March 27, 2003

Applicant is a small entity under 37 CFR 1.9 and 1.27.

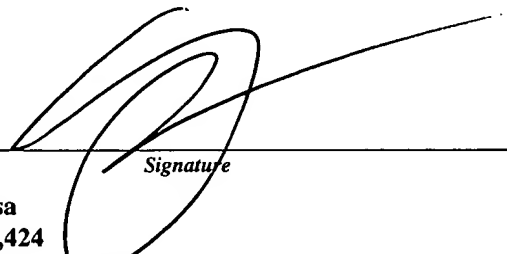
A verified statement of small entity status under 37 CFR 1.27:

- ☐ is enclosed.
- ☐ has already been filed in this application.

The fee for filing this Appeal Brief is: \$160.00

- ☒ A check in the amount of the fee is enclosed.
- ☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account. A duplicate copy of this sheet is enclosed.
- ☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 07-1180
A duplicate copy of this sheet is enclosed.

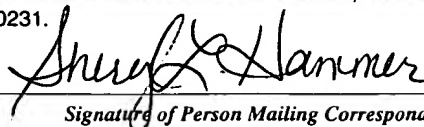
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Dated: May 27, 2003

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I certify that this document and fee is being deposited on 5-27-03 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.


Signature of Person Mailing Correspondence

Sheryl L. Hammer

Typed or Printed Name of Person Mailing Correspondence

CC: